

REMARKS/ARGUMENTS

I. Patentability Arguments

A. Claim Rejections

1) The Rejections of Claims 1, 2, 6-8, 12-13, and 18-20 Under 35 U.S.C. § 102(e) Should Be Withdrawn

Claims 1, 2, 6-8, 12-13 and 18-20 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Hillier et al., U.S. Patent No. 7,341,989 (hereinafter “Hillier”). Applicants respectfully request reconsideration and withdrawal of the rejections in view of the following arguments.

The Examiner again applies Hillier as of the foreign priority date of 9/12/2001. In their previous reply, Applicants cited MPEP 2136.03(I) which states that “Foreign applications’ filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes.” The Examiner found this argument unpersuasive because, according to the Examiner, “the applicable section is MPEP 2136.03(II), pertaining to references that resulted from an international (PCT) publication. Such is the case with Hillier.” Applicants reiterate that the Examiner is in error in according a foreign priority date to Hillier under § 102(e), as discussed in detail below.

First, Applicants wish to point out to the Examiner that Hillier is a U.S. patent which resulted from an international (PCT) *application*. In other words, Hillier is neither an international (PCT) publication nor is Hillier a reference that “resulted from an international (PCT) publication.” MPEP 2163.03(I), by its plain language, applies to (1) U.S. application publications (2) WIPO (i.e. international (PCT)) publications and (3) U.S. patents. According to MPEP 2163.03(I), foreign filing dates claimed via 35 U.S.C. 119(a)-(d), (f) or 365(a) in applications which have been published as U.S. patents may not be used as 35 U.S.C. 102(e) dates for prior art purposes. Because Hillier is a U.S. patent, MPEP 2163.03(I) forbids applying

this reference as of the foreign priority date claimed via 35 U.S.C. 119(a)-(d). Thus, the Examiner is clearly in error in finding that MPEP 2136.03(I) does not apply to Hillier.

Second, referring to MPEP 2136.03(II), this section states that for references resulting from an international application with an international filing date on or after 11/29/00, designating the US and published under PCT Article 21(2) in English, the international filing date is the U.S. filing date for prior art purposes under 35 U.S.C. 102(e). If such an international application properly claims benefit to an earlier-filed **U.S. or international application** or priority to an earlier filed **U.S. provisional application**, the reference may be applied under 35 U.S.C. 102(e) as of the earlier filing date, assuming all conditions are met. Thus, under this section, the earliest Hillier may be applied is the international filing date of 12/12/02.

For the Examiner's reference, Applicant submits with this response as Exhibit A, a copy of the flowchart at MPEP 706.02(f)(1)(III) for applying references under 35 U.S.C. 102(e). Page 1 of the flowchart applies to all U.S. patents, whenever filed, including publications of 371 applications. The flowchart, applied to Hillier (a U.S. patent of an International Application filed after 11/29/00 which designated the U.S. and the WIPO publication of which was in English), instructs that the "102(e) date is the international filing date or an earlier filing date for which a benefit is properly sought*". Following the asterisk, one is instructed to "consider benefit claims properly made under 119(e) to U.S. provisional applications, 120 to U.S. nonprovisional applications and 365(c) involving IAs. However, one is instructed **NOT to consider foreign priority claims**.

Accordingly, the earliest priority date for which Hillier may be applied under § 102(e) is the international filing date of Sept. 12, 2002. The present application, on the other hand, validly claims priority under § 119(a) of EP 02077221.6, filed June 7, 2002 and a certified copy of the foreign priority document was filed with the USPTO on December 7, 2004. Thus, the present application validly claims priority to a foreign application having a filing date (June 7, 2002) that antedates the earliest priority date of Hillier under § 102(e) (Sept. 12, 2002).

Because Hillier is unavailable as prior art against the present application under 35 U.S.C. 102(e) (or under any other section), Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(e).

2) The Rejections of Claims 3, 5, 16, and 17 under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 3, 5, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable Hillier. Applicants respectfully traverse this rejection.

For the reasons discussed above, Hillier is unavailable as prior art against the present application and therefore cannot serve as the basis of rejections under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request that the rejections under this section be reconsidered and withdrawn.

CONCLUSION

Applicants respectfully submit that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is hereby respectfully invited to contact the undersigned attorney at the number listed below.

Respectfully submitted,
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